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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/588,453	06/06/2000	Mohammad Husain	56728-P002US-10005779	9205

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DALLAS OFFICE OF FULBRIGHT & JAWORSKI L.L.P.
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EXAMINER

LANIER, BENJAMIN E

ART UNIT	PAPER NUMBER
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2132

DATE MAILED: 04/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/588,453

Applicant(s)

HUSAIN ET AL.

Examiner

Benjamin E Lanier

Art Unit

2132

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-41 and 51-55 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-41 and 51-55 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 June 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>4</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Group 1 in Paper No. 6 is acknowledged.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 14 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
4. Claim 14 recites the limitation "the payment processor" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-13, 17-30, 33, 35, 37, 39-41, 51-55 are rejected under 35 U.S.C. 102(b) as being anticipated by Deo, U.S. Patent No. 5,721,781. Referring to claims 1-3, 5-7, 11-13, 17, 18, 20-30, 35, 37, 39-41, 51-55, Deo discloses a smart card authentication system wherein a smart card is authenticated to perform various functions at a point of sale terminal or ATM, which meets the limitation of providing a transaction processing device to said subscriber. The smart card contains

Art Unit: 2132

a digital certificate issued by a certificate authority (Col. 6, lines 1-2), which meets the captured information being provided by a third party certifying authority. The user of the smart card is authenticated by inserting their PIN into the POS terminal, and authenticated. The digital certificates (captured information) contain a packet of unique information that is used for identification (Col. 5, lines 57-67), which meets the limitation of receiving information from a subscriber and storing said received information. In order to authenticate the card the terminal receives the smart card's encrypted digital certificate (captured information). The terminal decrypts it and checks the certificate for the proper identification information (Col. 7, lines 1-34), which meets the limitation of utilizing said captured information to receive verifying information about said subscriber and comparing said verifying information with said initial information to authenticate said subscriber.

Referring to claim 4, the digital certificate of the smart card would not have been previously provided to anyone other than the smart card by the certifying authority.

Referring to claims 8-10, Deo discloses that the encryption protocols use the public and private keys of the smart card and financial institutions (Col. 6, line 61 – Col. 7, line 45), which meets the limitations of encryption utilizing a private key unique to said transaction device and a public key of subscriber account provider.

Referring to claim 19, Deo discloses that a drivers license is a proper form of identification (Col. 1, line 27).

Claim Rejections - 35 USC § 103

Art Unit: 2132

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 31, 32, 34, 36, 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Deo, U.S. Patent No. 5,721,781, in view of Ramasubramani, U.S. Patent No. 6,233,577.

Referring to claims 31, 32, 34, 36, 38, Deo discloses a smart card authentication system wherein a smart card is authenticated to perform various functions at a point of sale terminal or ATM, which meets the limitation of providing a transaction processing device to said subscriber. The smart card contains a digital certificate issued by a certificate authority (Col. 6, lines 1-2), which meets the limitation of the captured information being provided by a third party certifying authority. The user of the smart card is authenticated by inserting their PIN into the POS terminal, and authenticated. The digital certificates (captured information) contain a packet of unique information that is used for identification (Col. 5, lines 57-67), which meets the limitation of receiving information from a subscriber and storing said received information. In order to authenticate the card the terminal receives the smart card's encrypted digital certificate (captured information). The terminal decrypts it and checks the certificate for the proper identification information (Col. 7, lines 1-34), which meets the limitation of utilizing said captured information to receive verifying information about said subscriber and comparing said verifying information with said initial information to authenticate said subscriber. Deo does not disclose that the user accesses the account via the Internet, that the terminal device is wireless, a username and password associated with the account, or that the user can select their own username and password. Ramasubramani discloses

Art Unit: 2132

a certificate management system wherein a user in the cellular network (wireless device) has an account that contains various information, such as a username and password created by the user (Col. 8, lines 49-52). The user can access their account by authenticating themselves through a website (Col. 7, lines 10-19).

With regards to claims 31, 34, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide access to the user's account through a web page in order to provide a wireless method of electronic commerce as disclosed in Ramasubramani (Col. 1, lines 28-37).

With regards to claim 36, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a username as well as a password or PIN in Deo in order to provide an added layer of security.

With regards to claim 38, it would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the user to select their own username and password in order for the username and password to be easily remembered by the user.

9. Claims 15, 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Deo, U.S. Patent No. 5,721,781, in view of Maes, U.S. Patent No. 6,016,476. Referring to claims 15, 16, Deo discloses a smart card authentication system wherein a smart card is authenticated to perform various functions at a point of sale terminal or ATM, which meets the limitation of providing a transaction processing device to said subscriber. The smart card contains a digital certificate issued by a certificate authority (Col. 6, lines 1-2), which meets the captured information being provided by a third party certifying authority. The user of the smart card is authenticated by inserting their PIN into the POS terminal, and authenticated. The digital

Art Unit: 2132

certificates (captured information) contain a packet of unique information that is used for identification (Col. 5, lines 57-67), which meets the limitation of receiving information from a subscriber and storing said received information. In order to authenticate the card the terminal receives the smart card's encrypted digital certificate (captured information). The terminal decrypts it and checks the certificate for the proper identification information (Col. 7, lines 1-34), which meets the limitation of utilizing said captured information to receive verifying information about said subscriber and comparing said verifying information with said initial information to authenticate said subscriber. Maes discloses a portable transaction system wherein a user's credit card information, that is being used at a POS terminal (device), is sent to the financial institution upon reception from the POS terminal. If the credit card information is valid, the financial institution sends the central server authorization information (verifying information) (Abstract, Col. 12, lines 55-66). It would have been obvious to one of ordinary skill in the art at the time the invention was made for the decrypted account information of Deo to be sent to the certifying party in order to properly verify the card information of the user as taught by Maes (Col. 12, lines 55-57).

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin E Lanier whose telephone number is 703-305-7684. The examiner can normally be reached on M-Th 7:30am-5:00pm, F 7:30am-4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on (703)305-1830. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2132

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Benjamin E. Lanier



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